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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,068	11/06/2006	Alan Jay Cook	330802-00004	9416
27160 7590 12/15/2009 KATTEN MUCHIN ROSENMAN LLP (C/O PATENT ADMINISTRATOR) 2900 K STREET NW, SUITE 200 WASHINGTON, DC 20007-5118				
EXAMINER				
BENEDIK, JUSTIN M				
ART UNIT		PAPER NUMBER		
3644				
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12/15/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,068

Applicant(s)

COOK ET AL.

Examiner

JUSTIN BENEDIK

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8, 10, 12, 58, 59, 62, 63 and 92-104 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 13-57 and 64-89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 10, 12, 58, 59, 62, 63 and 92-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The amendment filed 8/28/2009 has been entered. Claims 8, 10, 12, 58, 59, 62, 63 and 92-104 are pending, claims 1-7, 13-57 and 64-91 have been withdrawn, and claims 9, 11, 60, 61, 90 and 91 cancelled in the application. Claims 90 and 91 are included in the elected group but cancelled in the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 103 and 104 are rejected under 35 U.S.C. 102(b) as being anticipated by Thaler et al. (US 6,378,461 B1).

Regarding claims 103 and 104, Thaler teaches a litter cartridge (Tray in the Abstract) to be received in a self-cleaning litter box that incorporates a movable rake (43), having one or more sidewalls and a floor defining a single compartment (shown in Figure 18) configured to hold kitty litter to a fill line (38) and waste from an animal, as well as receive the rake (43) of the kitty litter machine, further comprising a removable cover (548) for closing the tray in a storage position, the cover would need to be removed when replacing said litter cartridge.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-12 and 58-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thaler et al. (US 6,378,461 B1) in view of Kerr (US 4,193,624).

Regarding claims 8, 94, 95, 100, Thaler teaches a **generally rectangular** tray (Abstract) **dimensioned** for use with a litter box having a movable rake (43) for receiving litter, having a waste cover (69) rotatable about a hinge (76) on one side of a waste area covering said waste area in a closed position.

Thaler does not teach the tray to be directly connected to the waste area.

Kerr teaches a tray (20) having two compartments directly connected to each other (Figs 2 and 3) having a cover (36) and **a liner (70) made from readily disposable material (Such as plastic)**. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate the connected tray and liner of Kerr into the invention of Thaler in order to provide a single disposable tray for ease of use and to make it easier to discard.

Further, It would have been obvious to one having ordinary skill in the art at the time the invention was made to integrate the tray and waste area container to make a single disposable tray/liner, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

Regarding claim 10, Thaler teaches the tray to be disposable (Abstract), therefore meaning it could be discarded after one use.

Regarding claim 12, Thaler and Kerr teach all of the limitations of claim 10.

They do not teach the tray to be made from paper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the tray out of paper, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. See also Ballas Liquidating Co. v. Allied industries of Kansas, Inc. (DC Kans) 205 USPQ 331.

Regarding claim 58, Thaler teaches litter to be used in said tray (Abstract).

Regarding claim 59, Thaler teaches a cover for the tray (548) providing privacy for the animal as well as storage.

Regarding claims 62 and 63, Thaler and Kerr teach all of the limitations of claim 8.

They do not teach the tray to be made from plastic or cardboard. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the tray out of paper, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. See also Ballas Liquidating Co. v. Allied industries of Kansas, Inc. (DC Kans) 205 USPQ 331.

Regarding claims 92 and 93, Thaler and Kerr teach all of the limitations of claim 8. It is old and well known in the art that typical molding and forming of plastics can involve any one of injection molding, casting, compression molding, plastic extrusion, vacuum casting etc.

Further, Applicant intends to claim a method step of forming the litter cartridge using a vacuum or injection type molding in an apparatus type claim. In other words, it's unclear what invention Applicant intends to claim because as currently presented, the claim encompasses two different statutory classes of invention, "a method of forming" and "a litter cartridge apparatus". (See Ex parte Lyell 17 USPQ2d 1548 (Bd. Pat. App. & Int 1990) OR (IPXL Holdings, L.L.C. v Amazon.Com, Inc., 430 F.3d 1377, 1384 (Fed. Cir. 2005))

Regarding claim 96, Thaler and Kerr teach all of the limitations of claim 8. Thaler further teaches the waste cover to have at least one coupling device (183 and 181) being able to be opened and closed.

Regarding claim 97, Thaler and Kerr teach all of the limitations of claim 96. They do not explicitly teach the coupling device to be magnetic. It would have been an obvious variant of the coupling tabs in Thaler and an obvious matter of design choice to use magnetic connections, since applicant has not disclosed that the function of the magnetic device would not solve any stated problem or is for any particular purpose that could not have been solved by a mechanical coupling, and it appears that the invention would perform equally as well with the coupling members (183 and 181) of Thaler.

Regarding claim 98, Thaler teaches the coupling device to be a mechanical coupling device (181 and 183).

Regarding claim 102, Thaler teaches a cat litter tray (Abstract) having a litter area (the tray) and a waste area (68) adapted to cooperate with a litter box having a movable rake (43), a single compartment (The tray as discussed in the Abstract is a

single compartment for carrying litter and waste) dimensioned to receive the rake and to move waste from the tray to the waste area, a waste cover (69) rotatable about a hinge (76) on one side of a waste area covering said waste area in a closed position, and a coupling device (183) on the waste cover coupling (181) to the lift plate of the litter box for enabling the cover to be opened or closed under the influence of the coupling device.

Thaler does not teach the tray to be directly connected to the waste area.

Kerr teaches a tray (20) having two compartments directly connected to each other (Figs 2 and 3) having a cover (36) and **a liner (70) made from readily disposable material (Such as plastic)**. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate the connected tray and liner of Kerr into the invention of Thaler in order to provide a single disposable tray for ease of use and to make it easier to discard.

Further, It would have been obvious to one having ordinary skill in the art at the time the invention was made to integrate the tray and waste area container to make a single disposable tray/liner, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Claim 99 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thaler et al. (US 6,378,461 B1) in view of Kerr (US 4,193,624) as applied to claim 59 above, and in further view of Crosse (US 6,065,429).

Regarding claim 99, Thaler and Kerr teach all of the limitations of claim 59.

They do not teach the litter cartridge to have a sealable shrink wrap type covering.

Crosse, in light of Figure 3, has a seal sheet (22) that is disclosed to be a sealable shrink wrap type covering. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate the sealable sheet of Crosse into the invention of Thaler in order to contain litter such that when replacing the tray the litter does not spill out.

Claim 101 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thaler et al. (US 6,378,461 B1) in view of Kerr (US 4,193,624) as applied to claim 8 above, and in further view of Scott (US 5,329,644).

Regarding claim 101, Thaler and Kerr teach all of the limitations of claim 8.

They do not teach the litter cartridge to have accordion type fold lines which enable the tray to be partially compressed.

Scott teaches a disposable device used to receive excrement having accordion type fold lines (12) such that the device can be compressed for mass shipment and storage. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate the folds of Scott into the invention of Thaler such that the device can be compressed for mass shipment and storage.

Response to Arguments

Applicant's arguments, see page 24 in the remarks section, filed 8/28/2009, with respect to the argument that the cited prior art does not teach a single non-compartmentalized tray have been fully considered and are not persuasive. Thaler

teaches a single non-compartmentalized tray (300) that has no compartments, is filled with litter to a fill line and slid out of the litter box for disposal or cleaning. **Also**, applicant argues that the rake in his invention does not need to be raised up to dispense the waste into the waste area. Examiner notes that in Figures 7B and 8B of the Application the rake is shown to be lifted up to lift the cover and dump the waste into the waste area. **Further**, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the rake not having to be raised) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). **Lastly**, in response to applicant's argument that the rake of the invention does not need to climb up the ramps as done so in Thaler, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this instance the structure of the tray is taught by Thaler and is capable of being used in a kitty litter box having a movable rake.

Applicant's arguments, see page 24 in the remarks section, filed 8/28/2009, with respect to the argument that the cited prior art does not teach the waste compartment to include litter have been fully considered and are not persuasive. In response to applicant's argument that the waste compartment needs to include litter, a recitation of

the intended use of the claimed invention must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this instance the structure of the waste compartment is taught by Thaler and is capable of containing litter. **Further**, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the waste compartment needs to include litter) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments, see page 24 in the remarks section, filed 8/28/2009, with respect to the argument that the cited prior art does not teach litter to act as a deodorizing agent in the same container as opposed to a different compartment as taught in Kerr and that Kerr teaches a compartmentalized container have been fully considered and are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the waste compartment needs to include litter for deodorizing the smell of the waste) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). **Further**, in response to applicant's argument that the waste

compartment needs to include litter and needs to be non-compartmentalized, a recitation of the intended use of the claimed invention must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this instance the structure of the waste non-compartmentalized container is taught by Thaler and is modified to include the liner and to integrate multiple compartments (Shown in Applicants disclosure for example in Figure 7B) using the Kerr reference. This structure is capable of containing litter.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to integrate the tray and waste area container to make a single disposable tray/liner, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN BENEDIK whose telephone number is (571)270-7824. The examiner can normally be reached on Monday-Thursday 8:00am-12:00pm and 1:00pm-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mansen can be reached on (571)272-6608. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 3644

Primary Examiner, Art Unit 3643